

## **REMARKS**

No amendments are presented in this Response.

Claims 1 – 10, 34, and 40 – 43 remain pending.

### **35 U.S.C. §112 Rejections**

In the Office Action claims 1, 6, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, it is stated that the Examiner cannot determine the functional limitation of “first reference is given effect.”

A person skilled in the art reading the specification would understand the claim limitation “when the first reference is given effect” to mean when the first reference is activated to obtain a result associated with the first reference.

Paragraph [0025] describes embodiments in which references are activated in various ways to obtain various results. The first embodiment discusses a reference such as an inclusion link being activated. “[I]f IP message 200 is opened in an email client program that supports HTML message scripting, inclusion link 212 is given effect in order to incorporate the testing and selecting scripts into email message 200.” That is, the activation of the inclusion link, which occurs automatically upon opening of the program that supports HTML scripting, causes test and select scripts to be incorporated into the email message.

Paragraph [0025] goes on to give an example of another reference being activated, i.e., a traversable link. “[I]f the email message 200 is displayed in a manner that does not support HTML scripting...then the user may click on a traversable link 213...in order to test the capabilities of the recipient system...” In this embodiment, the reference is activated manually, e.g., by a user clicking the link, in order to incorporate the test and select scripts.

The given examples are provided as evidence of teachings present in the specification that guide the interpretation of the language used in the claims for a person of ordinary skill in the art. They are not meant to act in a limiting sense.

Claims 1, 6, and 34 are additionally rejected under 35 U.S.C. 112, second paragraph, for providing insufficient numerical antecedent basis for the “first reference” limitation in the claims. The Applicants are confused by this rejection. In claim 1, line 4, “a first reference” is properly introduced at its first occurrence. Subsequent mention of “the first reference” clearly refers to this limitation. Claims 6 and 34 include similar language.

For at least these reasons, the Applicants assert that claims 1, 6, and 34 are sufficiently definite under 35 U.S.C. 112, second paragraph. Accordingly, the Applicants respectfully request that the Examiner withdraw these rejections of these claims.

### 35 U.S.C. § 103 Rejections

Claims 1-10, 23, 34, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sahai et al. (U.S. Patent 6,594,699) (hereinafter “Sahai”) in view of Parolkar et al. (U.S. Patent 6,704,396) (hereinafter “Parolkar”); claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sahai and Parolkar and further in view of Li et al. (U.S. Patent 6,345,279).

Parolkar has a reference date of February 27, 2002. The present application claims priority to U.S. Provisional Application No. 60/393,176 filed July 1, 2002. Therefore, Parolkar qualifies as a reference under 102(e). Please find attached a declaration of the inventors in accordance with 37 C.F.R. 1.131 and an accompanying exhibit. The declaration and exhibit show that the subject matter of the present application was conceived and actually reduced to practice prior to February 27, 2002. In particular, actual reduction to practice is shown to be at least as early as June 13, 2001. At this time, the inventors had developed the technology to allow for a message delivery application, referred to as the SMARTdelivery Package, that supports the claims presented herein. The development of the technology included internal testing sufficient to reveal that the operation of a SMARTdelivery Package, as described in the General Overview section of the exhibit, worked for its intended purpose.

The Applicants assert that the declaration and accompanying exhibit effectively swear behind Parolkar. Accordingly, the Applicants respectfully request that the Examiner withdraw these rejections of these claims.

Conclusion

For the above reasons, the Applicants believe that claims 1-10, 34, and 40 - 43 are patentable and respectfully request that the Examiner allow these claims as presented. If the Examiner has any questions, he is invited to contact the undersigned at (503) 796-2972.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,  
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